

REMARKS

The Examiner has required modification to the reissue declaration. A revised declaration is enclosed, indicating the relationship of the applications.

The Applicant does not enclose the original patent nor a statement of loss because the recently revised Code of Federal Regulations §1.178, effective September 21, 2004, no longer requires this. A copy of §1.178 is enclosed. The Applicant directs the Examiner's attention to the Federal Register, vol. 69, no. 182, p. 56521 (copy enclosed):

Section 1.178 is amended to eliminate the requirement for physical surrender of the original letters patent...

Amended §1.178 applies retroactively to all pending applications.

If the Applicant has misunderstood the revised rule, and the original patent must be surrendered, the Applicant will comply prior to issuance.

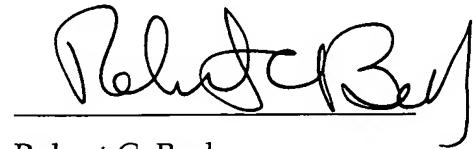
The Examiner has noted that revision to the application, to fully recite the chain of priority, is required. Such amendment to the text is made herein.

CONCLUSION

All of the claims remaining in this application should now be seen to be in condition for allowance. The prompt issuance of a notice to that effect is solicited.

Respectfully submitted,
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patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004]

§ 1.179 [Reserved]

[Removed and reserved, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

PETITIONS AND ACTION BY THE DIRECTOR

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

blanket exception for reissue applications. Regardless of when the reissue application was filed, applicant is not required to file an accompanying terminal disclaimer with a petition to revive under § 1.137.

Section 1.165: Section 1.165(b) is amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 Off. Gaz. Pat. Office 106 (May 22, 2001).

Section 1.173: Section 1.173(b) is amended to clarify that paragraphs (b)(1), (b)(2) and (b)(3) are directly related to, and should be read with, paragraph (b).

Section 1.175: Section 1.175 is amended by adding a new paragraph (e), which requires a new oath or declaration which identifies an error not corrected in an earlier reissue application be filed in any continuing reissue application that does not replace its parent reissue application.

Section 1.175 was previously interpreted to require any continuing reissue application whose parent application has not been abandoned to include an oath or declaration identifying at least one error being corrected, which error is different from the error(s) being corrected in the parent reissue (or an earlier reissue). Such interpretation is now clarified by the addition of paragraph (e) to § 1.175. Ordinarily, a single reissue application is filed to replace a single original patent and corrects all of the errors recognized by the applicant at the time of filing of the (single) reissue. If, during the prosecution of the reissue application, applicant (patentee) recognizes additional errors needing corrections, such corrections could, and should, be made in the same application. If, however, after the close of prosecution and up until the time that the first reissue issues, applicant recognizes a further error which needs correction and files a continuing reissue application, § 1.175(e) now explicitly requires applicant to include an oath or declaration which identifies an error which was not corrected in the parent reissue application or in an earlier reissue application, e.g., a grandparent reissue application.

Section 1.178: Section 1.178 is amended to eliminate the requirement for physical surrender of the original letters patent (*i.e.*, the "ribbon copy" of the original patent) in a reissue application, and to make surrender of

the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the *surrender of such patent* and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

See 35 U.S.C. 251, ¶ 1 (emphasis added).

While 35 U.S.C. 251, ¶ 1, requires a "surrender" of the original patent, it neither requires a physical surrender of the actual letters patent, nor a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (*i.e.*, the copy of the original patent grant) was previously required by rule via § 1.178; however, such submission was only symbolic because the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there was no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender of the letters patent. Conversely, it is beneficial to eliminate the requirement for physical surrender of the letters patent.

It is beneficial to both the Office and the public to establish that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent or the filing of a paper offering to physically surrender the letters patent (§ 1.178(a)).

Previously, the requirement for submission of the patent document compelled the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner had to search for it. If it was in the hands of a former employee, the patentee had to make an effort to secure it from that employee (who might not be on friendly

terms with the patentee). If the letters patent was obtained, it then had to be physically submitted without losing or destroying it. If the letters patent could not be obtained, the patent owner had to make a statement of loss (Form PTO/SB/55) or explain that it could not be obtained from the party having physical possession of it. The revision of § 1.178 eliminates these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

The requirement for submission of the letters patent copy of the patent previously provided an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue was not granted, the Office had to return the letters patent to the applicant where such was requested. The revision does away with the burden on the Office of processing, storing, and returning letters patent.

The previous requirement for submission of the original patent (the letters patent), or a statement as to its loss, resulted in a "built in" delay in the prosecution while the Office awaited submission of the letters patent or the statement of loss, which was often submitted only after an indication of allowance of claims. The revision reduces reissue application pendency because the Office no longer needs to delay prosecution while waiting for the letters patent or the statement of loss. Thus, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner puts reissue in step with other post patent proceedings for changes of patents which have no requirement for a statement of surrender (*e.g.*, reexamination certificate, certificate of correction).

Amended § 1.178 applies retroactively to all pending applications. For those applications with an outstanding requirement for the physical surrender of the original letters patent, applicant must timely reply that the requirement is moot in view of the implementation of the instant amended rule. Such a reply will be considered a complete reply to any requirement directed toward the surrender of the original letters patent. It is to be noted that the Office will not conduct a search to withdraw Office actions where the only outstanding requirement is compliance with the physical surrender of the original letters patent.

Example 1: An Office action issues prior to the effective date of the amendment to § 1.178 with only a requirement for a return of the original letters patent to the Office. Applicant fails to timely reply to the Office action,